REMARKS

Claims 1-22 are all the claims pending in the application. By this Amendment, Applicants amend claims 1, 2, 7 and 13 solely for the purpose of improved readability. Since such amendments are made to correct minor, basic elements, Applicants submit that that they do not narrow the scope of the claim and do not raise any Festo implications.

I. Summary of the Office Action

Applicants respectfully thank the Examiner for entering all of the amendments made in the abstract, specification and claims. Furthermore, Applicants thank the Examiner for initialing the requested portions on the PTO form-1449 submitted with the IDS of February 21, 2001. In addition, the Examiner withdrew his objections to the abstract and to the specification. However, the Examiner failed to acknowledge that the drawings are accepted. Therefore, Applicants respectfully request the Examiner to check the appropriate boxes on the Form PTO-326 indicating that the drawings are accepted.

Finally, claims 1-22 are rejected. The Examiner rejected claims 1-18 under 35 U.S.C. § 112, second paragraph, claims 1,2, 7-10, 13-16 and 19-22 under 35 U.S.C. § 102(b) and claims 3-6, 11-12 and 17-18 under 35 U.S.C. § 103(a).

II. Claim Rejections - 35 U.S.C. § 112

The Examiner rejected claims 1-18 under § 112, 2nd paragraph, as indefinite. The Examiner withdrew one of the previously asserted instances of the indefiniteness, but still asserts the remaining two specific instances. In order to overcome this rejection, Applicants respectfully traverse the rejection, as set forth below.

The Examiner asserts that with respect to claims 1, 2, 7, and 13, there is no structure claimed for the packaging material and packaging structure, i.e., the physical shape of the packaging material and packaging structure is not established.[1] Applicants respectfully request

[1] *See* the present Office Action at page 2, item 8; for details *also see* the previous Office Action at page 3, item 4, 3rd and 4th paragraphs.

the Examiner to withdraw this rejection of claims 2 and 13, in view of the self-explanatory amendment, as shown in the Appendix.

With respect to claims 1 and 7, Applicants respectfully disagree with the Examiner. Applicants have carefully studied 35 U.S.C. § 112, second paragraph, and MPEP §§ 2171-2174, which do not require limiting the claim by reciting physical shape of the packaging material.

To begin, the claims are not indefinite; they are merely broad. Breadth of a claim is not to be equated with indefiniteness.[2] For example, assuming *arguendo*, that a hypothetical applicant invents a material such as crystal for glassware. This crystal material may be used for glassware of any shape. Therefore, this hypothetical applicant would not include "the shape" of the crystal material into his claims. Further, when claiming chemical compositions, no shapes are specified. Similarly, the physical shape of the packaging material is irrelevant and may vary significantly in the present invention. In short, the shape of the packaging material has nothing to do with carrying out the purpose of the invention as set forth in claims 1 and 7. As a result, the definition of the invention in such broad terms does not make the claims indefinite.

Furthermore, an artisan of ordinary skill could now read the claims and understand the scope of patent protection sought to be protected. The MPEP, in §2173.05(a), states:

> If the claims, read in light of the specification, reasonably apprise those skilled in the art both of the utilization and scope of the invention, and if the language is as precise as the subject matter permits, the statute (35 U.S.C. 112, second paragraph) demands no more.[3]

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[2] *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971).

[3] Page 2100-147 of the MPEP Rev. 2, July 1996; right-hand column, lines 25-30; citing with approval Shatterproof Glass Corp. v. Libbey Owens Ford. Co., 758 F.2d 613 (Fed. Cir. 1985).

Since the language of the rejected claims reasonably apprises one of ordinary skill as to its scope, Applicants respectfully submit that the claims meet the requirements of 35 U.S.C. § 112, ¶ 2. Therefore, Applicants respectfully request the Examiner to withdraw this rejection.

III. Claim Rejections - 35 U.S.C. § 102(b).

The Examiner rejected claims 1, 2, 7-10, 13-16 and 19-22 under §102(b) as being anticipated by US Patent 4,376,816 to Hayashi et al. (hereinafter Hayashi). The Examiner considered previous arguments filed in the 1.111 Amendment but found them to be unpersuasive. Applicants respectfully traverse the rejection for the reasons set forth below and respectfully request the Examiner to withdraw the rejection.

Claims 1, 2, 7 and 13

With respect to all four independent claims, Applicants respectfully traverse this rejection for the following three reasons.

1) Hayashi teaches a method for storing sheets of photothermographic sheet material, which avoids deterioration in quality. Specifically, Hayashi is concerned with the problem of prolonged storage, especially when the photothermographic plates are stored with the use of intermediate paper (see col. 3, line 65 to col. 4, line 6). Thus, Hayashi teaches an intermediate paper with the Bekk values of 5 to 10,000 seconds and preferably the range of 200 to 5,000 seconds (col. 2, lines 50 to 54). In addition, Hayashi teaches as an example, values 360, 600 and 720 seconds.

However, Hayashi reference teaches away from the Bekk values below 5 seconds. Specifically, Hayashi teaches that Bekk smoothness below 5 seconds is disadvantageous because it tends to impair the surfaces of the photothermohraphic sheet material (col. 2, lines 55 to 65). Hayashi fails to teach or suggest Bekk smoothness values below 5 seconds. Thus, Hayashi fails to teach the lower range of 3 seconds as set forth in claims 1, 2, 7 and 13.

2) The Examiner asserts that Hayashi's photothermographic sheet material is equivalent to a planographic plate (see page 5, item 4 of the present office action). However, claims 1 and 7, as now amended, recite a planographic printing plate whereas claims 2 and 13 recite "at least one

planographic plate." And these recitations are not only with respect to the manner in which a claimed article is intended to be employed (i.e., not only in the preamble of the claim). A planographic[4] plate includes but is not limited to a photosensitive plate as well as a heat sensitive plate, whereas photothermographic deals only with the heat sensitive plates.

Conventionally different methods of development are employed for these two types of plates, photothermographic and photosensitive (see page 4, first two paragraphs of the specification and page 5, third and fourth paragraph of the specification). Furthermore, the two printing plates have different properties and would required different packaging material (intermediate paper). Therefore, Hayashi fails to disclose planographic plate as set forth in independent claims 1, 2, 7, and 13. Accordingly, Hayashi discloses smoothness for photothermographic plates only and does not teach or suggest smoothness for the photosensitive plates. As a result, Hayashi's range of smoothness is fundamentally different form the ranges of smoothness recited in the claims of the present invention.

3) Finally, claims 1 and 2 recite the range of 3 seconds to 55 seconds, whereas claims 7 and 13 recite the range of 3 seconds to 900 seconds. Applicants respectfully point out that the ranges as set forth in claims 1, 2, 7 and 13 are fundamentally different from the Hayashi's range. To begin, even the broadest range (3 to 900 seconds) is about two orders of magnitude lower than the range taught by Hayashi (range between 5 to 10,000). As a result, the range as set forth in claims 1, 2, 7 and 13 does not constitute the majority of the Hayashi's range as claimed by the Examiner; it is significantly narrower than Hayashi's range.

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[4] For example, planography is a process of printing from a surface on which the printing areas are ***not raised*** but are ink receptive (emphasis added), whereas photothermographic imaging is a process of writing or printing involving the use of heat; especially a raised-printing process in which matter printed by letterpress is dusted with powder and heated to make the ***lettering rise*** (emphasis added). E.g., see USP 6,365,336 to Maskasky.

Claims 7 and 13

In addition to the arguments hereinabove, with respect to the present invention as set forth in claims 7 and 13 there is a surprising result. Hayashi is consistent with the conventional knowledge that smoother surfaces (ones with the highest Bekk values) prevent unwanted peeling. When the package is being transported with printing plates and intermediate papers, the friction between non-imaging surface and the protection paper causes unwanted peeling. Contrary to this conventional knowledge, the present inventors have found as set forth in claims 7 and 13 that it is the rougher surfaces which prevent this unwanted peeling. Thus, Applicants respectfully request the examiner to withdraw this rejection of independent claims 7 and 13.

Claims 1 and 2

With respect to claims 1 and 2, Applicants respectfully traverse this rejection for the following additional reasons. Specifically, Hayashi fails to disclose every element as set forth and arranged in the claims. "[W]hen, as by a recitation of ranges or otherwise, a claim covers several compositions, the claim is 'anticipated' if *one* of them is in the prior art."[5] On the other hand, however, when the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. See MPEP § 2131.03. In this case, the claims are directed to a narrow range that is overlapped by the range disclosed in Hayashi, and there is evidence of unexpected results.

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[5] *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (citing *In re Petering*, 301 F.2d 676, 682 USPQ 275, 280 (CCPA 1962)) (emphasis in original).

Thus, although Hayashi's range overlaps that claimed by Applicants, the reference fails to disclose a value within Applicants' claimed range. That is, Hayashi's Examples 1, 2, and 4, respectively disclose Bekk smoothnesses of 360, 600, and 720 seconds. None of these values is within Applicants' claimed range of from 3 to 55 seconds, or within Applicants' claimed range of from 3 to 100 seconds.

Second, Applicants have shown unexpected results for their narrow range. As set forth in the present specification, a Bekk smoothness from 3 seconds to 55 seconds—for the surface of the packaging material to contact the non-image side of the planographic sheet—is an important feature that produces unexpected results. Because of its smoothness, the packaging material of the present invention achieves a high separability from a non-imaging surface of a planographic printing plate, and can be produced at low costs.[6] In particular, the upper limit of 55 seconds is an important element of the present invention. When the smoothness rises above 55 seconds, there is difficulty separating a packaging material from a planographic printing plate. Note Table 1, wherein the example having smoothness of 65 seconds sometimes adhered to and was not separated from the planographic printing plate. Also, see page 16, line 8 - page 18, line 2. That is, when the smoothness is above 55 seconds, the packaging material sometimes adheres to and is not separated from the non-imaging surface, and is fed together with the planographic printing plate in an automatic plate-making machine. Therefore, a smoothness between 3 seconds and 55 seconds according to the present invention, assures that the packaging material can be separated from the non-image surface with certainty in an automatic plate-feeding mechanism and deterioration of the imaging surface is prevented.[7]

Therefore, Hayashi does not disclose the claimed range with "sufficient specificity" and is insufficient to establish anticipation. As set forth in the specification, a Bekk smoothness from 3 seconds to 100 seconds—for the surface of the packaging material that contacts the non-image side of the planographic sheet—is an important feature that produces unexpected results.

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[6] Specification at page 7, 1st full paragraph.

[7] Specification at the paragraph bridging pages 17 and 18.

Because of its smoothness, the packaging material of the present invention can prevent peeling of the film with more certainty.[8]

For the above reasons, Hayashi fails to disclose Applicants' range with "sufficient specificity" and, therefore, fails to anticipate Applicants' claims 1, 2, 7, and 13. Further, although Hayashi recognizes separability—i.e., preventing blocking—as desirable, he still finds an upper limit of 10,000 seconds, which is 2-3 orders of magnitude greater than Applicants' upper limit on smoothness. Therefore, one of ordinary skill in the art would not readily envisage Applicants' narrow range of smoothness of 3 to 55 seconds, or Applicants' narrow range of smoothness of 3 to 100 seconds, from Hayashi's broad range. Accordingly, Hayashi also fails to render obvious Applicants' claimed smoothness ranges.

Thus, Applicants respectfully request the Examiner to reconsider and withdraw the rejections of independent claims 1, 2, 7, and 13. Also, Applicants respectfully submit that claims 8-10, 14-16 and 19-22 are allowable at least by virtue of their dependency.

Summary of the argument with respect to § 102 rejection

To sum up, Hayashi fails to teach or suggest a planographic printing plate as set forth in claims 1, 2, 7 and 13, and instead only teaches photothermographic sheets. In addition, Hayashi fails to teach the lower boundary of the range as set forth in these independent claims. Specifically, the Examiner teaches away from Bekk values below 5 seconds. In addition the upper boundary at least two orders of magnitude higher than the boundary set forth in independent claims 1, 2, 7 and 13, and Hayashi determines this range to solve a different problem. For all these reasons, Applicants respectfully submit that independent claims 1, 2, 7 and 13 are patentably distinguishable from Hayashi. Applicants therefore respectfully request the Examiner to withdraw this rejection of independent claims 1, 2, 7 and 13. Also, Applicants respectfully submit that claims 8-10, 14-16 and 19-22 are allowable at least by virtue of their dependency on claims 1, 2, 7 and 13.

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[8] Specification at page 8, lines 12-20; page 20, table 2; and page 21, 1st full paragraph.

IV. Claim Rejections - 35 U.S.C. § 103(a).

The Examiner rejected claims 3, 5, 11, and 17 under §103(a) as being unpatentable over Hayashi in view of US Patent 6,306,254 to Usui (hereinafter "Usui '254") and further in view of Japanese 03036545 to Goto et al. (hereinafter "Goto"). Applicants respectfully traverse this rejection because the reference fail to establish *prima facie* obviousness in that they do not teach or suggest every element as set forth in Applicants' claims.

The Examiner asserts that Applicants are using "piecemeal analysis of the references".[9] Applicants respectfully disagree. Applicants have already demonstrated that Hayashi does not meet all the requirements of independent claims 1, 2, 7 and 13. Usui '254 and Goto do not teach or suggest a planographic printing plate or the ranges as set forth in claims 1, 2, 7 and 13. Accordingly, for the sake of argument, even assuming that one of ordinary skill in the art were motivated to combine Hayashi, Usui '254, and Goto, as suggested by the Examiner, any such combination would still not include all of the elements as set forth in Applicants' claims 1, 2, 7 and 13. Therefore, Applicants were[10] and are asserting that all three references taken as whole fail to teach certain features set forth in the independent claims.

Moreover, the Examiner rejected claims 4, 6, 12, and 18, under §103(a) as being unpatentable over Hayashi in view of US Patent 5,729,962 to Dirx (hereinafter Dirx) and further in view of Japanese 8-39958 to Usui et al. (hereinafter Usui '958). Applicants respectfully traverse this rejection because the reference fail to establish *prima facie* obviousness in that they do not teach or suggest every element as set forth in Applicants' claims.

Again, the Examiner asserts that Applicants are using "piecemeal analysis of the references".[11] Again, Applicants respectfully disagree. Applicants have already demonstrated that Hayashi does not meet all the requirements of independent claims 1, 2, 7 and 13. Usui '958 and Dirx do not teach or suggest a planographic printing plate or the ranges as set forth in claims

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[9] *See* page 9, item 15 of the final office action.

[10] *See* Amendment under 37 C.F.R. § 1.111, pages 9-10.

[11] *See* page 9, item 16 of the final office action.

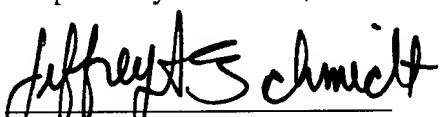
1, 2, 7 and 13. Accordingly, for the sake of argument, even assuming that one of ordinary skill in the art were motivated to combine Hayashi, Usui '958, and Dirx, as suggested by the Examiner, any such combination would still not include all of the elements as set forth in Applicants' claims. Therefore, Applicants were[12] and are asserting that all three references taken as whole, fail to teach certain features set forth in claims 1, 2, 7 and 13.

V. Conclusion and request for telephone interview.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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[12] *See* Amendment under 37 C.F.R. § 1.111, page 10.